IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:		§	
	Richard E. Waitkus, Jr.	§	Group Art No. **2857**
		§	
Serial No.: **10/774,240**		§	
		§	Examiner: **Tung S. Lau**
Filed:	**February 6, 2004**	§	
		§	
For:	**Systems and Methods for Material Management**	§	Atty Docket No.: **016093.0118**

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre- Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, Applicant submits the following brief summary of selected portions of the prosecution history of the Application.

I. Brief Summary of Selected Portions of Prosecution History

a. Final Office Action

In a Final Office Action of September 16, 2005 (the Final Office Action), all claims were rejected under 35 U.S.C. § 102, but as described in further details below, the Final Office Action failed to set forth a *prima facie* rejection of several of the claims.

Accordingly, Applicant filed a Response to the Final Office Action on December 16, 2005 (the Response to Final Office Action). In this response the Applicant pointed out that the Final Office Action did not establish a *prima facie* rejection of the claim under 35 U.S.C. § 102, and requested that the claims be allowed. *See* Response to Final Office Action, pages 10-15.

b. Advisory Action

In an Advisory Action of January 9, 2005 (the Advisory Action), the Examiner maintained the rejection of Claims 1, 3-11, and 13-32.

II. Errors of Record

a. Failure to Establish a Prima Facie Rejection

Applicant maintains that the Final Office Action did not establish a *prima facie* rejection of all the claims in the application and that the Advisory Action did not address the deficiencies pointed out by the Applicant in the Response to the Final Office Action.

First, as Applicant showed in the Response to the Final Office Action, the cited reference, U.S. Patent No. 6,123,017 to Little, *et al.* does not disclose each element of the independent claims 1, 15, and 24. *See* Response to Final Office Action, pages 10-15. As Applicant pointed out in the Response to the Final Office Action, Little does not disclose "automatically determining an optimal time to empty each waste container, based on the fullnesses of the waste container and **scheduling factors including customer preferences and waste hauler limitations**.," as required by Claim 1. *See* Response to Final Office Action, page 11. Applicant further pointed out that Little does not disclose similar limitations

in Claim 15 and 24. *See* Response to Final Office Action, pages 12-14. The Advisory Action, states that:

> B. Applicant argues in the arguments that the prior art fail to teach 'scheduling factors including customer preferences and waste hauler limitations.'
>
> The examiner reminds to the applicants that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404 05, 162 USPQ 541, 550 51 (CCPA 1969). While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allowed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Guens, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Little clearly discloses 'scheduling factors including customer preferences (Col. 1, Lines 40-9) and waste hauler limitations (Col. 2, Lines 10-11)'. In Col. 1, Lines 40-65 Little talks about the customer preference as being on a call basis, and on Col. 2, Lines 10-11 Little clearly discloses waste hauler limitations.

Advisory Action, page 2.

Applicant understands that the "the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.'" Applicant notes, however, that the anticipation arguments advanced in the Final Office Action and Advisory Action are not reasonable in light of any reading of the specification, as Applicant has repeatedly pointed out. *See* Response to Final Office Action, pages 10-14. Both the Final Office Action and the Advisory Action have cited the same portions of Little without any explanation of how the subject of those portions disclose the claim limitation. In turn, Applicant has shown how the disclosure at those portions of Little does not map to the claim limitations. *See* Response to Final Office Action, pages 10-14. In short, Little does not disclose "automatically determining an optimal time to empty each waste container, based on the fullnesses of the waste container and **scheduling factors including customer preferences and waste hauler limitations**.," as required by Claim 1.

> C. Applicant argues in the arguments that the prior art fail to teach 'automatically determining optimal time to empty the waste container'. Little discloses 'automatically determining optimal time to empty the waste

> container' in Col. 1-2, Lines 65-9, where Little discloses the dispatcher evaluates the data to determined fullness and based on these evaluations, the scheduled time of pick up and replacement of the container are performed.

Advisory Action, page 2.

Applicant again notes that claim 1, and the other independent claims do not merely require "automatically determining optimal time to empty the waste container." Rather, claim 1 requires "automatically determining an optimal time to empty each waste container, **based on the fullnesses of the waste container and scheduling factors including customer preferences and waste hauler limitations**." Claim 15 requires "automatically determining an optimal time to empty each waste container, based on the fullnesses of the waste container and **scheduling factors including customer preferences and waste hauler limitations**." Claim 24 requires that the computer "automatically determine an optimal time to empty each waste container, based on the fullnesses of the waste container and **scheduling factors including customer preferences and waste hauler limitations**." The Advisory Action, therefore does not correct the deficiencies in the Final Office Action with respect to independent claims 1, 15, and 24.

Neither the Final Office Action, nor the Advisory Action have even attempted to show an optimal time determination based on both waste hauler limitations and customer preferences, but this is what the claim element requires.

Furthermore, in Applicant's Response to the Final Office Action, Applicant pointed out that the portion of Little cited to show the "a number of drivers available at a specified time," element of claim 5, actually discusses a series of pressure measurements. *See* Response to Final Office Action, pages 15-16. Applicant's argument with respect to this limitation, which is also present in claim 30 was not addressed in the Advisory Action.

II. Request for Relief from Errors

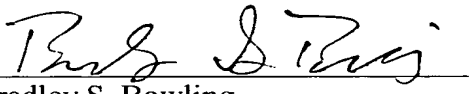
As a *prima facie* rejection has not been established against Claims 1, 3-11, and 13-32, Applicant respectfully requests allowance of Claims 1, 3-11, and 13-32.

CONCLUSION

For the reasons presented above, Applicant respectfully requests relief from the Errors of Record. If the PTO deems that an interview is appropriate, Applicant would appreciate the opportunity for such an interview.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant



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January 17, 2006

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